

REMARKS

The Office Action presents a Restriction Requirement under 35 U.S.C. § 121, requiring the Applicant to elect for substantive examination the invention of one of three groups allegedly present in the application as filed. In particular, the Office Action identifies the following groups of claims:

- Group I, claims 1-15
- Group II, claims 16-19, and
- Group III, claims 20-27.

In response to these requirements, **Applicant hereby elects for examination Group I (claims 1-15)** with traverse. Examination on the merits is requested

Notwithstanding the above election, the Applicant respectfully requests that the restriction requirement be reconsidered. The Office Action also states that Groups II and III are related as a subcombinations disclosed as useable together in a single combination. The Office Action also states that Groups I, II and III are related as a subcombinations disclosed as useable together in a single combination. According to the Office Action, the subcombinations are distinct because they do not overlap in scope and are not obvious variants, and at least one subcombination is separately useable.

Regarding Groups II and III, the separate utility of Group III identified in the Office Action is “establish alarm parameters based on measured data.” The Applicant respectfully submits that this utility is merely a generic element of that included in Group II by, for example, “identifying a plurality of incremental thresholds for negative pressure readings and positive pressure readings” and later “lighting a first pressure LED” as stated in claim 16. Thus, the Applicant submits the basis for the restriction is invalid.

Regarding Groups I, II, and III, the subcombination of Group II was indicated in the Office Action to have separate utility such as “a device for respiratory.” The Applicant respectfully submits that the stated utility not sufficient to establish that the stated subcombinations do not overlap or have separate utility. The Applicant’s representatives are unable to determine the separate utility that this phrase is intended to communicate. However,

the Applicant submits the system of Group I and methods of Group II and III are related as a product and process of use. Thus, the Applicant submits the basis for the restriction is invalid.

Furthermore, the Applicant submits that a combined search and examination of Groups I, II and III would not pose a serious burden to the Office. See MPEP § 803 and 808.02. The Office Action asserts that the inventions identified by these groups are distinct and have acquired a separate status in the art. In accordance with MPEP § 803, restriction is appropriate only when the groups are shown to be distinct and when there would be a “serious burden” placed on the Examiner to examine the claims without restriction. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803 (emphasis added). Each group of claims in the present application relate generally to systems and methods for respiratory monitoring. Some of the claim limitations present throughout Group I are also present in Groups II or III or have parallel limitation. Therefore, the allegedly distinct groups asserted in the Office Action would nonetheless require the Examiner to search the same subclasses and consider the same prior art references. Consequently, Applicant maintains that the examination of all of the pending claims together will not place a serious burden upon the Examiner.

Application Ser. No. 10/724,870
Response and Amendment filed October 10, 2006
In response to Office Action dated September 11, 2006

Conclusion

In view of the foregoing, the Applicant respectfully requests that the Examiner enter the above-noted amendments before the application is examined upon the merits, and that the above remarks be fully considered in conjunction therewith. Timely allowance of all currently pending claims and the issuance of a Notice of Allowance are requested.

Applicant has filed this Response and Amendment without increasing the number of claims above the number previously submitted or paid for. Accordingly, no additional claims fees are believed to be due at the present time. If such fees or any other fees associated with the filing of this paper are due at this time, please charge the fees to our Deposit Account No. 50-1349. Also, please credit any overpayments to Deposit Account No. 50-1349.

The Examiner is invited to contact Applicant's undersigned representative via telephone if such would expedite prosecution of this application toward allowance.

Respectfully submitted,

Dated: October 10, 2006

HOGAN & HARTSON LLP
555 13th Street, N.W.
Washington, D.C. 20004
Telephone: 202-637-5600
Facsimile: 202-637-5910

By: Thomas W. Edman
Celine Jimenez Crowson
Registration No. 40,357

Thomas W. Edman
Registration No. 51,643

Customer No. 24633